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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/807,965	08/31/2001	Toshio Tamura	P20962	6657

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GREENBLUM & BERNSTEIN, P.L.C.  
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RESTON, VA 20191

EXAMINER
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FISCHER, ANDREW J

ART UNIT	PAPER NUMBER
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3627

DATE MAILED: 02/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/807,965

Applicant(s)

TAMURA ET AL.

Examiner

Andrew J. Fischer

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**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 February 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 3-68 is/are pending in the application.
- 4a) Of the above claim(s) 29-33 and 44-68 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 3-28 and 34-43 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Acknowledgements*

1. Applicants' amendment filed November 7, 2005 is acknowledged. Accordingly, claims 3-68 remain pending.
2. Claims 29-33 and 44-68 were withdrawn from further consideration pursuant to 37 C.F.R. §1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made with traverse in the reply filed on February 24, 2005.
3. This Office Action, the "First Final Office Action" is given Paper No. 20060125.
4. The previous office action on the merits<sup>1</sup> mailed April 21, 2005 and given Paper No. 04102005 is designated as the "First Non Final Office Action."
5. This application in an image file wrapper ("IFW") application. Applicants' response is therefore separated before being placed into the IFW system (*i.e.* claims, remarks, drawings, etc. are separated and independently scanned). To ensure proper handling by the Examiner, the Examiner highly recommends Applicants place the application serial no (*e.g.* 06/123,456) in a header or footer (or other appropriate area) of *each* page submitted. At the very least, the Examiner highly recommends this practice for all pages listing the claims.
6. All references in this Office Action to the capitalized versions of "Applicants" refers specifically the Applicants of record. References to lower case versions of "applicant" or "applicants" refers to any or all patent "applicants." Unless expressly noted otherwise,

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<sup>1</sup> "In the PTO, patent applications are examined for compliance with the statutory provisions of Title 35, United States Code, as set forth in sections 100, 101, 102, 103, and 112. These are considered to be examinations 'on the merits.'" *In re Harnisch*, 631 F.2d 716, 721, 206 USPQ 300, 304 (CCPA 1980).

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references to “Examiner” in this Office Action refers to the Examiner of record while reference to or use of the lower case version of “examiner” or “examiners” refers to examiner(s) generally.

***Claim Rejections - 35 USC §101***

7. 35 U.S.C. §101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

8. Claims 34-43 are rejected under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter. The basis of this rejection is set forth in a two-prong test:

- (1) The invention must be within the technological arts; and
- (2) The invention must produce a useful, concrete, and tangible result.

9. Claims 34-43 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claim(s) are directed to neither a “process” nor a “machine,” but rather embraces or overlaps two different statutory classes of invention. See MPEP §2173.05(p) II or Ex Parte Lyell, 17 USPQ2d 1548 (B.P.A.I., 1990); and *Holdings LLC v. Amazon.com Inc.*, 77 USPQ2d 1140 (Fed. Cir. 2005).

***Claim Rejections - 35 USC §112 2<sup>nd</sup> Paragraph***

10. The following is a quotation of the second paragraph of 35 U.S.C. §112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

11. Claims 3-28 and 34-43 rejected under 35 U.S.C. §112, 2<sup>nd</sup> paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims are replete with errors. Some examples follow.

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a. In claim 3, the phrase “standard product memory” is indefinite because the term “standard” is unclear. While one of ordinary skill in the art clearly understands what is ‘a memory,’ “a standard product memory implies” something else’s. In other words, it is unclear if Applicants are claiming memory with particular data or some unique type of memory. After review of all the evidence of record and because of the lack of evidence to the contrary, the Examiner adapts the presumption that the term “standard product memory” connotes a different meaning than the term “memory.” See *e.g. CAE Screenplates Inc. v. Heinrich Fielder GmbH & Co. KG*, 224 F.3d 1308, 1317, 55 USPQ2d 1804, 1810 (Fed. Cir. 2000) (“In the absence of any evidence to the contrary, we must presume that the use of these different terms in the claims connotes different meanings.”).<sup>2</sup>

b. In claims 34, 39 and 40, the phrase “standard commodity memory” is indefinite. The same arguments noted above with respect to “standard product memory” apply equally to “standard commodity memory.”

c. In claim 34, the phrase “customers may communicate” in line 6 does not grammatical sense. “A claim must be read in accordance with the precepts of English grammar.” *In re Hyatt*, 708 F.2d 712, 714, 218 USPQ 195, 197 (Fed. Cir. 1983).

d. Claims 34-43 are directed to neither a “process” nor a “machine,” but rather embraces or overlaps two different statutory classes of invention. It is therefore unclear

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<sup>2</sup> See also *Fonar Corp. v. Johnson & Johnson*, 821 F.2d 627, 632, 3 USPQ2d 1109, 1113 (Fed. Cir. 1987) (noting that the meaning of claim terms must be defined in a manner that is consistent with its appearance in other claims in the same patent); *c.f. Bancorp Services LLC v. Hartford Life Insurance Co.*, 69 USPQ2d 1996, 2000-01 (Fed. Cir. 2004) (“That inference, however, is not conclusive; it is not unknown for different words to be used to express similar concepts, even though it may be poor drafting practice.”)

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whether Applicants are claiming a process or a machine. See MPEP §2173.05(p) II, *Ex Parte Lyell*, 17 USPQ2d 1548 (B.P.A.I. 1990), and *Holdings LLC v. Amazon.com Inc.*, 77 USPQ2d 1140 (Fed. Cir. 2005). In particular, claim 34 recites “and by use of this terminal, the user may realize his business . . . .” It therefore objectively appears that Applicants are claiming ‘a use’ or ‘using’ their claimed support system. If Applicants overcome the related §101 rejection noted above, this particular 35 U.S.C. §112, 2<sup>nd</sup> paragraph will also be withdrawn.

e. In claims 34, 39, and 40, the phrase “patterned special type commodity” is indefinite because one of ordinary skill in the art can not understand what is and what is not a “patterned special type commodity.”

### ***Claim Rejections - 35 USC §102***

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. §102 that form the basis for the rejections under this section made in this Office Action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States. . . .

(c) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

13. Claims 3-28, 34-43, as understood by the Examiner, are rejected under 35 U.S.C. §102(e) as being anticipated by James H. Greene’s Production and Inventory Control Handbook (“Green”) in view of Donald W. Dobler et. al.’s Purchasing and Supply Management, Text &

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Cases ("Dobler"). Greene discloses the claimed invention including a means for inputting information (a keyboard); a means for displaying information (a computer monitor); and an information management system (the CPU).

***Claim Rejections - 35 USC §103***

14. The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office Action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. Claims 3-28, 34-43, as understood by the Examiner, are alternatively rejected under 35 U.S.C. §103(a) as being unpatentable over Greene in view of Dobler and Johnson et. al. (U.S. 6,023,683) ("Johnson").<sup>3</sup> It is the Examiner's principle position that the claims are anticipated because it is inherent that the system is transmitting to the product facility instructions for providing the product.

However if not inherent, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Greene as taught by Dobler and Johnson to include transmitting to the product facility instructions for providing the product. Such instructions could include 'drop shipping' or providing an address to where the products should be delivered.

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<sup>3</sup> See MPEP §2112 expressly authorizing alternative §102/§103 rejections when the question of inherency is present in the anticipation rejection.

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16. Because Applicants have not objectively indicated and redefined claim limitation(s) to have meanings other than their ordinary and accustomed meanings, the Examiner concludes that Applicants have decided not to be their own lexicographer. To support this position, the Examiner relies on the following factual findings. First and as noted in the previous Office Action,<sup>4</sup> the Examiner has carefully reviewed the specification and prosecution history and can not locate any lexicographic definition(s). Second, the Examiner finds that not only have Applicants not pointed to definitional statements in their specification or prosecution history, Applicants have also not pointed to a term or terms in a claim with which to draw in those statements<sup>5</sup> with the required clarity, deliberateness, and precision.<sup>6</sup> Third, after receiving express notice in the previous Office Action of the Examiner's position that lexicography is not invoked,<sup>7</sup> Applicants have not pointed out the "supposed errors" in the Examiner's position regarding lexicography invocation in accordance with 37 C.F.R. §1.111(b) (i.e. Applicants have not argued lexicography is invoked). Finally and to be sure of Applicants' intent, the Examiner also notes that Applicants have declined the Examiner's express invitation<sup>8</sup> to be their own

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<sup>4</sup> See the First Non Final Office Action, Paper No. 04102005, Paragraph No. 20.

<sup>5</sup> "In order to overcome this heavy presumption in favor of the ordinary meaning of claim language, it is clear that a party wishing to use statements in the written description to confine or otherwise affect a patent's scope must, *at the very least*, point to a term or terms in the claim with which to draw in those statements. [Emphasis added.]" *Johnson Worldwide Assocs. v. Zebco Corp.*, 175 F.3d 985, 989, 50 USPQ2d 1607, 1610 (Fed. Cir. 1999).

<sup>6</sup> "The patentee's lexicography must, of course, appear 'with reasonable clarity, deliberateness, and precision' before it can affect the claim." *Renishaw PLC v. Marposs Societa' per Azioni*, 158 F.3d 1243, 1249, 48 USPQ2d 1117, 1121 (Fed. Cir. 1998) citing *In re Paulsen*, 30 F.3d 1475, 1480, 31 USPQ2d 1671, 1674 (Fed. Cir. 1994).

<sup>7</sup> See again the First Non Final Office Action, Paragraph No. 20.

<sup>8</sup> Id.



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lexicographer.<sup>9</sup> It remains the Examiner's position that these requirements were reasonable.<sup>10</sup>

Accordingly and for due process purposes, the Examiner gives notice that for the remainder of the examination process (and unless expressly noted otherwise by the Examiner), the heavy presumption in favor of the ordinary and accustomed meaning is not overcome; the claims therefore continue to be interpreted with their "broadest reasonable interpretation . . . ." *In re Morris*, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997).<sup>11</sup> The Examiner now relies heavily and extensively on this interpretation.<sup>12</sup> Unless expressly noted otherwise by the Examiner, the preceding claim interpretation principles in this paragraph apply to all examined claims currently pending.

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<sup>9</sup> See e.g. *Fuji Photo Film Co. v. ITC*, 386 F.3d 1095, 72 USPQ2d 1769, 1773 (Fed. Cir. 2004) (noting that applicants' failure to correct the examiner's characterization of an element of claim interpretation is nevertheless an indication of how a claim should be interpreted since applicant declined the examiner's express invitation to correct a possible error in claim interpretation: "applicant's attention was called to the examiner's interpretation of [how the element was interpreted by the examiner, and] applicant was invited to correct the examiner's interpretation—an invitation the applicant did not accept.").

<sup>10</sup> The Examiner's requirements on this matter were reasonable on at least two separate and independent grounds. First, the Examiner's requirements were simply an express request for clarification of how Applicants intend their claims to be interpreted so that lexicography (or even an *attempt* at lexicography) by Applicants was not inadvertently overlooked by the Examiner. Second, the requirements were reasonable in view of the USPTO's goals of compact prosecution, productivity with particular emphasis on reductions in both pendency and cycle time, and other goals as outlined in the USPTO's The 21<sup>st</sup> Century Strategic Plan, February 3, 2003 available at [www.uspto.gov/web/offices/com/strat21/index.htm](http://www.uspto.gov/web/offices/com/strat21/index.htm) (last accessed January 25, 2006).

<sup>11</sup> See also *In re Bass*, 314 F.3d 575, 577, 65 USPQ2d 1156, 1158 (Fed. Cir. 2002) ("In examining a patent claim, the PTO must apply the broadest reasonable meaning to the claim language, taking into account any definitions presented in the specification. Words in a claim are to be given their ordinary and accustomed meaning unless the inventor chose to be his own lexicographer in the specification") (citations omitted); *In re Etter*, 756 F.2d 852, 858, 225 USPQ 1, 5 (Fed. Cir. 1985) (en banc); and MPEP §§ 2111 and 2111.01.

<sup>12</sup> See 37 C.F.R. § 1.104(c)(3) which states in part: "the examiner may rely upon admissions by applicant . . . as to *any matter* affecting patentability . . . . [Emphasis added.]"

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17. Under the broadest reasonable interpretation standard noted above and unless expressly modified in this Office Action, the Examiner maintains his interpretations including the statements and/or definitions of claim limitations as noted in First Non Final Office Action. Contrary to Applicants' arguments on page 23, ¶6 of their Remarks, those previous definitions are part of the administrative record and, in accordance with *In re Morris*, are provided simply as a factual source to support the Examiner's claim interpretations (and ultimately the Board of Patent Appeals and Interferences claim interpretations if necessary<sup>13</sup>) during ex parte examination.

18. The Examiner maintains his position that Applicants' system claims are "product," "apparatus," or more specifically, "machine" claims.<sup>14</sup>

19. The Examiner maintains his position regarding functional language.

20. The Examiner maintains his position that the claims do not contain any product-by-process limitations. See the First Non Final Office Action, Paragraph No. 24, beginning on page

12. This issue will not be further addressed by the Examiner.

### ***Response to Arguments***

21. Applicants' arguments filed November 7, 2005 have been fully considered but they are not persuasive.

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<sup>13</sup> See *Gechter v. Davidson*, 116 F.3d 1454, 1460, 43 USPQ2d 1030, 1035 (Fed. Cir. 1997) ("[W]e hold that the Board is required to set forth in its opinions specific findings of fact and conclusions of law adequate to form a basis for our review.").

<sup>14</sup> Products may be either machines, manufactures, or compositions of matter. MPEP §2106 IV B. 2 (a).

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22. Unless expressly noted otherwise in this paragraph or elsewhere in this Office Action, the Examiner maintains his findings of fact and conclusions of law as noted in the previous office action(s). Additionally, all objection(s) and/or rejection(s) from any previous office action that are not maintained in this Office Action are either overcome by Applicant(s) and/or are hereby withdrawn.

23. As noted above and contrary to Applicants' arguments on page 23, ¶6 of their Remarks, the Examiner maintains that for ex parte examination purposes, the definitions provided by the Examiner are controlling.

24. Applicants' also state that "applicants do not agree that all of the claim terms are only to be given their ordinary and accustomed meaning."<sup>15</sup> So if Applicants do not agree, the Examiner again respectfully requests Applicants (in their next response that is made of record) to point out which particular claim terms that they believe *do not* warrant the ordinary and accustomed meaning.

25. Applicants argue that "the specification should be carefully consulted for each claim term . . . ." <sup>16</sup> For ex parte examination purposes, the Examiner disagrees.

26. Applicants also argue that "Applicants should not have to define every claim term at this point in the prosecution."<sup>17</sup> The Examiner agrees since the Examiner has now repeatedly stated that *all claim terms receive their ordinary and accustomed meaning*.

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<sup>15</sup> See Applicants "Remarks" filed November 7, 2005, Page 23, ¶6.

<sup>16</sup> Id.

<sup>17</sup> Id.

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27. Because Applicants do not understand the role of lexicography during *ex parte* examination, the following is provided.

***Lexicography***

28. The Examiner maintains his position that Applicants are not their own lexicographer. The Examiner maintains his positions on lexicography. While Applicants' arguments are noted for the record, the Examiner respectfully disagrees.

29. To be clear, the Examiner has simply required that if Applicants know of or intended to be their own lexicographer, the Examiner respectfully requested that they point it out now. It is the Examiner's position that based upon the Examiner's positions as communicated to Applicants in the office actions and in light of the requirements of 37 C.F.R. §1.111(b), Applicants are legally required to point out any *known* lexicographic terms that are located in any claim under examination. Moreover, it is the Examiner's position that Applicants have incorrectly interpreted the requirements 37 C.F.R. §1.111(b).

Because Applicants have demonstrated their unfamiliarity of the requirements of 37 C.F.R. §1.111(b) and its application to lexicography invocation (and/or lack thereof), the Examiner will review lexicography invocation and its impact during *ex parte* examination. However because the Examiner's concern is only *ex parte* examination and not *inter partes* litigation,<sup>18</sup> the following analysis applies to *ex parte examination only*. Unless expressly noted otherwise, the Examiner takes no position on how the claims are interpreted after issuance.

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<sup>18</sup> "The business of the PTO is patentability, not infringement." *In re Hogan* 559 F.2d 595, 607, 194 USPQ 527, 538 (CCPA 1977).

***Why is Lexicography Important?***

30. To begin with, the Examiner notes that there are four ways, methods, or factors of *properly* reading the specification into the claims:

[We] ... may constrict the ordinary meaning of a claim term in at least one of four ways. First, the claim term will not receive its ordinary meaning if the patentee acted as his own lexicographer and clearly set forth a definition of the disputed claim term in either the specification or prosecution history. . . . Second, a claim term will not carry its ordinary meaning if the intrinsic evidence shows that the patentee distinguished that term from prior art on the basis of a particular embodiment, expressly disclaimed subject matter, or described a particular embodiment as important to the invention. . . . Third, . . . a claim term also will not have its ordinary meaning if the term chosen by the patentee so deprives the claim of clarity as to require resort to the other intrinsic evidence for a definite meaning. . . . Last, as a matter of statutory authority, a claim term will cover nothing more than the corresponding structure or step disclosed in the specification, as well as equivalents thereto, if the patentee phrased the claim in step- or means-plus-function format. *CCS Fitness Inc. v. Brunswick Corp.*, 288 F.3d 1359, 1366-67, 62 USPQ2d 1658, 1662-63 (Fed. Cir. 2002) (citations and internal quotations omitted).<sup>19</sup>

So unless an applicant or patentee can utilize one or more of the these four factors, it is improper to read the specification into the claims.

31. While all four *CCS Fitness* Factors are available to interpret the claims during inter partes litigation, only *CCS Fitness* Factor #1 (*i.e.* Lexicography) and *CCS Fitness* Factor #4 (*i.e.* 12<sup>6th</sup> paragraph) are available during ex parte examination.

32. Regarding *CCS Fitness* Factor #2, prosecution disclaimer, this is a tool reserved exclusively for inter partes litigants. To the best of the Examiner's knowledge, prosecution disclaimer has never been using during ex parte examination because it subverts the notice

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<sup>19</sup> The four methods enumerated in *CCS Fitness* are really not new. *CCS Fitness* however was one of the first Federal Circuit cases to clearly and succinctly enumerate all four factors in a single case. For this reason, the Examiner will henceforth refer to these factors, methods, or ways, as the four "*CCS Fitness* Factors."

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function reversed during examination. It developed as way of preserving a claim interpretation that—although improper during ex parte examination—was nevertheless relied upon to issue the application. To maintain validity of a particular interpretation used to issue the application, the doctrine of prosecution disclaimer was developed. See *Omega Engineering Inc. v. Raytek Corp.*, 334 F.3d 1314, 67 USPQ2d 1321 (Fed. Cir. 2003) for an excellent discussion on this topic.

33. Regarding *CCS Fitness Factor #3*, indefiniteness, if a claim is indefinite on its face, the entire claims is indefinite. “Until the meaning of a term or phrase is clear, a rejection under 35 U.S.C. 112 2<sup>nd</sup> paragraph is appropriate.” MPEP §2173.05(a). In other words, “[i]f the scope of the invention sought to be patented is unclear from the language of the claim, a second paragraph rejection will properly lie.” *In re Wiggins*, 488 F.2d 538, 179 USPQ 421, 423 (CCPA 1973) (citations and quotations omitted). Resorting to the specification to cure the indefiniteness is only proper during inter partes litigation. It is inappropriate during ex parte examination.

34. In other words, during inter partes litigation, courts must look to the specification for a meaning that is consistent with the specification.<sup>20</sup> However during ex parte examination, because the applicant can amend his or her claims, Factors #2 and #3 are improper.

35. The reasoning behind this principle was clearly stated in the ex parte examination case of *In re Prater*. “There are quite sound reasons why, in an infringement suit on an issued patent, courts may sometimes interpret patent claims in the light of the specification so as to protect only that phase of the claimed invention that constitutes patentable subject matter and thus do justice

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<sup>20</sup> See e.g. *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 39 USPQ2d 1573, 1577 (Fed. Cir. 1996)(“it is always necessary to review the specification to determine whether the inventor has used any terms in a manner inconsistent with their ordinary meaning.”)(citations omitted).

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and equity between the parties.” *In re Prater*, 415 F.2d 1393, 162 USPQ 541, 550 (CCPA 1969) (citations omitted).

36. To be clear, this different method of interpreting the claims is not optional:

[T]he Board is *required* to use a different standard for construing claims than that used by district courts. We have held that it is *error for the Board to apply the mode of claim interpretation that is used by courts in litigation*, when interpreting the claims of issued patents in connection with determinations of infringement and validity. Instead, as we explained above, the PTO is obligated to give claims their broadest reasonable interpretation during examination. [Emphasis added.]” *In re American Academy of Science Tech Center*, 367 F.3d 1359, 1369, 70 USPQ2d 1827, 1834 (Fed. Cir. 2004).

37. In fact, the Federal Circuit has warned the Board about improperly reading the specification into the claims:

“Nevertheless, this court counsels the PTO to avoid the temptation to limit broad claim terms solely on the basis of specification passages. Absent claim language carrying a narrow meaning, the PTO should only limit the claim based on the specification or prosecution history when those sources expressly disclaim the broader definition . . . .” *In re Bigio*, 381 F.3d 1320, 1325, 72 USPQ2d 1209, 1211 (Fed. Cir. 2004)(citations omitted).

38. Finally and if there is any doubt, the Examiner notes that the MPEP also supports the Examiner’s position that *only* lexicography or 35 U.S.C. 112 6<sup>th</sup> paragraph are available during ex parte examination to incorporate the specification into the claims. MPEP §2111.01<sup>21</sup> begins:

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<sup>21</sup> MPEP §2111.01, 8<sup>th</sup> Edition, Rev 2, May 2004.

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While the claims of issued patents are interpreted in light of the specification, prosecution history, prior art and other claims, this is *not the mode* of claim interpretation to be applied during examination. . . . It is *only when* the specification provides definitions for terms appearing in the claims that the specification can be used in interpreting claim language [*i.e. CCS Fitness Factor 1: Lexicography*]. . . . There is one exception, and that is when an element is claimed using language falling under the scope of 35 U.S.C. 112, 6th paragraph (often broadly referred to as means or step plus function language) [*i.e. CCS Fitness Factor 4*]. In that case, the specification must be consulted to determine the structure, material, or acts corresponding to the function recited in the claim. [Emphasis added. Citations omitted.]

39. Thus the MPEP clearly states that during ex parte examination, the specification can be used to interpret the claims “only when” attempting to use either lexicography (*CCS Fitness Factor #1*) and/or 35 U.S.C. §112 6<sup>th</sup> paragraph (*CCS Fitness Factor #4*). In other words, Factors #2 and #3 are *not* available during ex parte examination.

***Why Would an Applicant Use Lexicography?***

40. “It is black letter law that a patentee can choose to be his or her own lexicographer by clearly setting forth an explicit definition for a claim term that could differ in scope from that which would be afforded by its ordinary meaning.” *Jack Gluttman, Inc.*, 302 F.3d 1352, 1360, 64 USPQ2d 1302, 1307 (Fed. Cir. 2002)(citations and quotations omitted).

41. There are two (2) primary reasons for invoking lexicography. First, an applicant may use lexicography when he or she is unsure of a term’s meaning or when an applicant desires to define an entirely new term. “This is done in order to hold open the possibility of obtaining a patent where an inventor is not schooled in the terminology of the technical art to which his invention pertains or where there is a need to coin new expressions with which to communicate that invention.” *Lear Siegler, Inc. v. Aeroquip Corp.*, 733 F.2d 881, 221 USPQ 1025, 1031 (Fed. Cir. 1984)(citations omitted).



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42. Second and more commonly used, lexicography may be used to *redefine* a claim term which already processes a clear, ordinary and accustomed meaning. “But even where the claim language is not ambiguous, the prosecution history limits the interpretation . . . . Thus, the prosecution history limits even clear claim language . . . .” *Schumer v Laboratory Computer Systems, Inc.*, 308 F.3d 1304, 1313, 64 USPQ2d 1832, 1839 (Fed. Cir. 2002) (citations and quotations omitted). This ‘redefined term’ or lexicographic definition is not limited by known usages either. The redefined term or lexicographic definition may be *contrary to* or *inconsistent with* one or more of the term’s ordinary meanings. “It is a well-established axiom in patent law that a patentee is free to be his or her own lexicographer and thus may use terms in a manner contrary to or inconsistent with one or more of their ordinary meanings.” *Hormone Research Found., Inc. v. Genentech, Inc.*, 904 F.2d 1558, 1563, 15 USPQ2d 1039, 1043 (Fed. Cir. 1990). The redefined term or lexicographic definition may also *expand* or *further limit* the known ordinary and accustomed meanings. “A patent applicant may consistently and clearly use a term in a manner either more or less expansive than its general usage in the relevant art, thereby expanding or limiting the scope of the term in the context of the patent claims.” *Alloc Inc. v. ITC*, 342 F.3d 1361, 68 USPQ2d 1161, 1165 (Fed. Cir. 2003).

***Why is Lexicography of Increased Importance During Ex Parte Examination?***

43. Because only *CSS Fitness* Factors #1 and #4 are available during ex parte examination, lexicography is of increased importance because it is the *primary way* to overcome the broadest reasonable interpretation. In other words, when an applicant acts as his or her own lexicographer and successfully redefines a claim to have a meaning other than its ordinary and accustomed meaning, the claims must be examined using that meaning. See *In re Zletz*, 893 F.2d 319, 321,

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13 USPQ2d 1320, 1322 (Fed. Cir. 1989) (“When the Applicant states the meaning that the claim terms are intended to have, the claims are examined with that meaning, in order to achieve a complete exploration of the Applicant's invention and its relation to the prior art.”).<sup>22</sup>

44. Thus, in order to properly construe and then subsequently reject claims under *e.g.* §102 or §103, examiners more-often-than-not *must* use the ‘broadest reasonable interpretation.’ Because lexicography trumps the ‘broadest reasonable interpretation,’ lexicography has a profound impact on claim construction during *ex parte* examination. It is because of this profound impact that lexicography is frequently at issue in claim construction disputes during *ex parte* examination. In fact, when applicants successfully invokes lexicography, the Examiner has more-often-than-not allowed those claims.

45. It is important to remember that because *In re Morris* requires examiners to set forth a reasonable basis to support the examiner’s claim interpretation under the broadest reasonable interpretation<sup>23</sup> and because examiners very frequently use dictionaries to support their claim interpretation(s),<sup>24</sup> lexicography will even trump these dictionary definitions. “In short, the

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<sup>22</sup> See also MPEP §2173.05(a).

<sup>23</sup> “Absent an express definition in their specification [*i.e.* lexicography], the fact that appellants can point to definitions or usages that conform to their interpretation does not make the PTO’s definition unreasonable when the PTO can point to other sources that support its interpretation.” *Morris*, 127 F.3d at 1056, 44 USPQ2d at 1029.

<sup>24</sup> “It is well settled that dictionaries provide evidence of a claim term’s ordinary meaning. Such dictionaries include dictionaries of the English language, which in most cases will provide the proper definitions and usages, and technical dictionaries, encyclopedias and treatises, which may be used for established specialized meanings in particular fields of art.” *Inverness Medical v. Biomeditech Co.*, 309 F.3d 1365, 1369, 64 USPQ2d 1926, 1930 (Fed. Cir. 2002) (citations and quotations omitted).

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presumption in favor of a dictionary definition will be overcome where the patentee, acting as his or her own lexicographer, has clearly set forth an explicit definition of the term different from its ordinary meaning.” *Texas Digital Systems, Inc. v. Telegenix, Inc.*, 308 F.3d 1193, 1204, 64 USPQ2d 1812, 1819 (Fed. Cir. 2002).

### ***Lexicography Procedurally***

46. After having established the importance of lexicography during ex parte examination, its procedural implications must also be examined.

47. To begin with, the Examiner notes that when construing claims “[t]he general rule is, of course, that terms in the claim are to be given their ordinary and accustomed meaning.” *Johnson Worldwide Assocs. v. Zebco Corp.*, 175 F.3d at 989, 50 USPQ2d at 1610. In other words, “there is a heavy presumption in favor of the ordinary meaning of claim language as understood by one of ordinary skill in the art.” *Bell Atlantic Network Services Inc. v. Covad Communications Group Inc.*, 262 F.3d 1258, 1268, 59 USPQ2d 1865, 1870 (Fed. Cir. 2001) (citations omitted).<sup>25</sup>

48. During ex parte examination, the “ordinary and accustomed meaning” is interpreted to mean that claims are given their “broadest reasonable interpretation . . . .” *In re Morris*, 127 F.3d at 1054, 44 USPQ2d at 1027; *In re Prater*, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-51

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<sup>25</sup> See also *Teleflex Inc. v. Ficosa North America Corp.*, 299 F.3d 1313, 1325, 63 USPQ2d 1374, 1380 (Fed. Cir. 2002) (“We indulge a heavy presumption that a claim term carries its ordinary and customary meaning.”) (citations and quotations omitted); and *Deering Precision Instruments L.L.C. v. Vector Distribution Systems Inc.*, 68 USPQ2d 1716, 1721 (Fed. Cir. 2003) (“Generally speaking, we indulge a ‘strong presumption’ that a claim term carries its ordinary and customary meaning.”) citing *Tate Access Floors, Inc. v. Interface Architectural Res., Inc.*, 279 F.3d 1357, 1369, 61 USPQ2d 1647 (Fed. Cir. 2002).

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(CCPA 1969).<sup>26</sup> In fact, in *ex parte* cases, the Federal Circuit interchanges or substitutes “broadest reasonable interpretation” with ‘ordinary and accustomed meaning.’ See *e.g. In re Bass*, 314 F.3d at 577, 65 USPQ2d at 1158 (“In examining a patent claim, the PTO must apply the *broadest reasonable meaning* to the claim language . . . . Words in a claim are to be given their *ordinary and accustomed meaning* unless the inventor chose to be his own lexicographer in the specification. [Emphasis added.]”).

49. Additionally, this requirement that examiners interpret the claims with the “broadest reasonable interpretation” is not optional since “the PTO is *obligated* to give claims their broadest reasonable interpretation during examination. [Emphasis added.]” *In re American Academy of Science Tech Center*, 367 F.3d 1359, 70 USPQ2d 1827, 1834 (Fed. Cir. 2004) (citations and quotation omitted). See also *Spring Window Fashions LP v. Novo Indus., L.P.*, 323 F.3d 989, 994, 65 USPQ2d 1826, 1830 (Fed. Cir. 2003) (“an examiner has the *duty* to police claim language by giving it the broadest reasonable interpretation . . . . [Emphasis added.]”). Examiners therefore are obligated to start with the ‘broadest reasonable interpretation.’

50. Furthermore, requiring examiners to use the broadest reasonable interpretation “serves the public interest by reducing the possibility that claims, finally allowed, will be given broader scope than is justified.” *In re Bigio*, 381 F.3d 1320, 1324, 72 USPQ2d 1209, 1211 (Fed. Cir. 2004)(citations and quotations omitted). This makes sense because the applicant still has an opportunity to amend the claims. “The broadest reasonable interpretation rule recognizes that before a patent is granted the claims are readily amended as part of the examination process.

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<sup>26</sup> See also MPEP §2111; *In re Etter*, 756 F.2d 852, 858, 225 USPQ 1, 5 (Fed. Cir. 1985) (*en banc*).

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Thus, a patent applicant has the opportunity and responsibility to remove any ambiguity in claim term meaning by amending the application.” Id.

***What’s the Standard for Lexicography Invocation?***

51. It is the Examiner’s position that to overcome this “heavy presumption” in favor of the ordinary and accustomed meaning or to overcome the ‘broadest reasonable interpretation,’ a party must do so by ‘clear and convincing’ evidence.<sup>27</sup> First, because the use of a “presumption” alone implies just a ‘preponderance of the evidence,’<sup>28</sup> the use of the phrase “heavy presumption” or “strong presumption” implies a standard *higher* than ‘preponderance of the evidence.’ In other words, if *e.g.* a party needed only ‘preponderance’ to invoke lexicography, the Federal Circuit would have simply used ‘presumption’ instead of “*heavy* presumption.” Second, so that the word “heavy” or “strong” is not vitiated, the standard for lexicography invocation must be at least *greater than* a ‘preponderance of the evidence.’ And because ‘clear and convincing evidence’ is the next standard above ‘preponderance of the evidence,’<sup>29</sup> logic

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<sup>27</sup> Clear and Convincing Proof: “That proof which results in reasonable certainty of the truth of the ultimate fact in controversy. Proof which requires more than a preponderance of the evidence but less than proof beyond a reasonable doubt. Clear and convincing proof will be shown where the truth of the facts asserted is highly probable.” Black’s Law Dictionary, Abridged 6th Ed., West Publishing Co., 1991.

<sup>28</sup> Preponderance of the Evidence : “The greater weight of the evidence; the burden of proof in a civil trial which the jury is instructed to find for the party that, on the whole, has the stronger evidence, however slight the edge might be. —Also termed *preponderance of proof*, *balance of probability*. Cf. *clear and convincing evidence* under EVIDENCE.” Id.

<sup>29</sup> See *e.g. Buildex Inc. v. Kason Indus., Inc.*, 849 F.2d 1461, 1463, 7 USPQ2d 1325, 1327 (Fed. Cir. 1988) (noting that the ‘clear and convincing’ standard is an intermediate standard which lies between ‘beyond a reasonable doubt’ and a ‘preponderance of the evidence.’)(citations omitted).

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dictates that the standard for lexicography invocation during inter partes litigation must be ‘clear and convincing evidence.’

52. After establishing that the ‘clear and convincing’ standard is the standard need to invoke lexicography during inter partes litigation, logic also dictates that is it is also the standard for lexicography invocation—and thus deviation from a term’s “broadest reasonable interpretation”—during ex parte examination.

53. Some applicants have argued that while they agree with the Examiner’s position that the ‘clear and convincing evidence’ standard is the standard for lexicography invocation during inter partes litigation, ‘clear and convincing evidence’ is not the standard for lexicography invocation during ex parte examination. Initially, these applicants correctly point out that the presumption bestowed by 35 U.S.C. §282 does not apply to ex parte examination. Thus, they conclude that the standard for lexicography invocation during ex parte examination is only a ‘preponderance of the evidence.’ The Examiner respectfully disagrees.

54. It is critical to keep in mind that the presumption bestowed by 35 U.S.C. §282 arises only after issuance and applies only to *validity* determinations. The Examiner therefore agrees that 35 U.S.C. §282 bestows a presumption of validity on issued patents.

55. Thus, this presumption of validity results in differing standards for *validity* (or invalidity) purposes only. See *e.g. In re Caveney*, 761 F.2d 671, 674, 226 USPQ 1, 3 (Fed. Cir. 1985) (“From *In re Etter*, 756, F.2d 852, 225 USPQ 1 (Fed. Cir. 1985) (en banc), it is apparent that, due to 35 U.S.C. §282, the standard of proof required to properly reject the claims of a patent

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application is necessarily lower than that required to invalidate patent claims”). However even though claim construction is a question of law,<sup>30</sup> it is not necessarily a *validity* determination.<sup>31</sup>

56. For example, 35 U.S.C. §282 can not change the standard of invocation of 35 U.S.C. §112 6<sup>th</sup> paragraph (*i.e.* *CCS Fitness Factor #4*) because the invocation of 35 U.S.C. §112 6<sup>th</sup> paragraph it is not a *validity* determination.

57. It is well established that ‘preponderance of the evidence’ is the standard used in both ex parte examination and inter partes actions to invoke 35 U.S.C. §112 6<sup>th</sup> paragraph. The use of “means” as a presumption for invoking §112 6<sup>th</sup> paragraph (and thus the *standard* for invoking §112 6<sup>th</sup> paragraph) applies equally to both ex parte examination and inter partes litigation alike.<sup>32</sup> Determining the invocation of §112 6<sup>th</sup> paragraph is therefore not a *validity* determination.

58. Like 35 U.S.C. §112 6<sup>th</sup> paragraph, the standard for determining the invocation of lexicography must also be the same for both ex parte examination and inter partes litigation since lexicography invocation is also *not* a validity determination. In other words, §282 can not bestow any deference between two valid claim constructions.

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<sup>30</sup> See *e.g. Cybor Corp. v. FAS Techs., Inc.*, 138 F.3d 1448, 1454, 46 USPQ2d 1169, 1174 (Fed. Cir. 1998) (en banc)(noting that claim construction is a question of law).

<sup>31</sup> If ultimately the Examiner’s standard for lexicography invocation is held to be erroneous, 35 U.S.C. §282 can not change the standard for lexicography invocation—whatever the standard ultimately is. At the very least, the standard should be the same for both ex parte examination and inter partes litigation.

<sup>32</sup> “It is well settled that a claim limitation that actually uses the word ‘means’ invokes a rebuttable presumption that § 112, ¶ 6 applies. By contrast, a claim term that does not use ‘means’ will trigger the rebuttable presumption that § 112, ¶ 6 does not apply. The term ‘means’ is central to the analysis.” *Apex Inc. v. Raritan Computer Inc.*, 66 USPQ2d 1444, 1450 (Fed. Cir. 2003) (internal citations and quotations omitted).

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59. In conclusion, because 35 U.S.C. §282 can not change the standard for claim construction, if ‘clear and convincing evidence’ is the standard used during inter partes litigation to determine if a party desires to be his or her own lexicographer, ‘clear and convincing evidence’ must also be the standard for invoking lexicography during to ex parte examination.

***When Do We Look to the Specification for these Lexicographic Terms?***

60. Having established that it is the objective evidence of record on the effective filing date that ultimately controls the meaning of lexicographic terms (and non-lexicographic terms for that matter), the issue of ‘when’ or ‘at what time’ do we examine the specification and claims for lexicographic terms frequently arises. The Examiner frequently receives responses such as ‘such discussions of lexicography are premature’ or ‘we need not get into lexicography now.’

61. But before answering the question of *when* to look for lexicographic terms, it is important to remember that the result (*i.e.* determining whether or not there is a lexicographic definition present in the claims) is independent of when the analysis is done. In other words, because the decision of whether a patent applicant is his or her own lexicographer was finalized on the effective filing date of the application, the time at which the specification and claims are analyzed for lexicographic terms is immaterial. If done correctly, the result of each analysis is always the same. The analysis can clearly be done during ex parte examination, inter partes litigation, or never at all.

62. Some examples will help illustrate this point. *In re Bass* and *Jack Gluttman, Inc. v. Kopykake Enterprises, Inc.* are excellent examples of lexicography invocation and its effects. Starting with *In re Bass* (and suppose the Bass application ultimately became a U.S. patent), the effects of lexicography invocation on a subsequent inter partes litigation case—should it have



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occurred—would be straightforward. The record is clear. A litigant would be hard pressed to offer opposing interpretation of “motorized sports boat.”

63. However *Jack Gluttman* is less straight forward since the Federal Circuit was silent as to the examiner’s interpretation of “photocopy machine.” From the Federal Circuit opinion, the lexicographic term did not come up in examination. The lexicographic term was however ‘uncovered,’ ‘corralled,’ or ‘ascertained’ during the inter partes litigation. While this ‘discovery’ often occurs when lexicographic terms which are revealed during inter partes litigation, it is important to keep in mind that this revealing or detection is not a *change* in claim interpretation but is instead, an objective discovery of what was already there the whole time. In fact, terms or definitions that actually *change* claim term meaning by their inclusion *after* the effective filing date of the application are improper new matter under either 35 U.S.C. §112 1<sup>st</sup> paragraph and/or 35 U.S.C. §132 since it is axiomatic that any *change* from an initial meaning would clearly constitute new matter.

64. Because the timeframe during which lexicography is investigated is immaterial to the ultimate determination of whether a patent applicant is his or her own lexicographer, the analysis can be done at any time. While some timeframes are more preferred than others, the Examiner offers the following four (4) reasons for inquiring about lexicography in the first office action.

65. First: Lowering Pendency. As noted above, lexicography has a profound impact on claim construction during ex parte examination because successful lexicography trumps the broadest reasonable interpretation. Because the Examiner can more often-than-not allow a claim with a successful lexicographic term, an initial inquiry about lexicography during examination is an effective tool enabling an examiner to quickly pass the application to allowance thereby reducing application pendency.

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66. Second: Public Notice. Should the application issue as a patent, the public benefits because actual notice is given expressly stating how the issued claim(s) should be interpreted. The record will reveal whether or not an applicant intends to have any lexicographic terms in his or her issued claims.

67. Third: Removing Ambiguities of How and When to Read the Claims in Light of the Specification As of September 13, 2004,<sup>33</sup> the USPTO now requires detailed invocation of *CCS Fitness Factor #4* (i.e. 35 U.S.C. §112 6<sup>th</sup> paragraph) in applicant's appeal brief. In particular, 37 C.F.R. §41.37 now requires applicant to expressly state the function and delineate the corresponding structure in any claim phrases that invoke 35 U.S.C. §112 6<sup>th</sup> paragraph. Previously, disagreements between applicant and examiner over the invocation of 35 U.S.C. §112 6<sup>th</sup> paragraph clearly resulted in significant differences in claim interpretation. However this new rule removes any disagreement and removes the guesswork out of determining if and when 35 U.S.C. §112 6<sup>th</sup> paragraph is invoked. Because of this new rule, differences in claim interpretations between applicant and examiner are substantially reduced.

With determining the invocation of 35 U.S.C. §112 6<sup>th</sup> paragraph no longer an issue, the only ambiguity remaining of when to properly read the specification into the claims is lexicography. By investigating lexicography in the first office action, this final ambiguity is also removed. Thus, with the new 35 U.S.C. §112 6<sup>th</sup> paragraph rule and the examiner's investigation of lexicography completed, applicant's argument that 'the claims must be read in light of my specification' have been considered but rendered legally moot. Any ambiguities of how and when to read the claims in light of the specification are removed.

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<sup>33</sup> See, Rules and Practice before the Board of Patent Appeals and Inferences, Federal Register, 49960, Vol. 69, No. 155, August 12, 2004.

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68. Forth: Reduction in Litigation Costs. Although somewhat related to public notice, investigating whether or not an applicant intended to be his or her own lexicographer may reduce litigation costs by eliminated the need for the litigation in the first place. In fact, the Federal Circuit recognized this in *Bancorp Services LLC v. Hartford Life Insurance Co.*, 359 F.3d 1367, 69 USPQ2d 1996 (Fed. Cir. 2004) where the court stated that had lexicography been used, certain aspects of the litigation might have been avoided. “The failure to define the term is, of course, not fatal, for if the meaning of the term is fairly inferable from the patent, an express definition is not necessary (although of course the inclusion of a definition would have avoided the need for this time-consuming and difficult inquiry . . .).” *Bancorp Services LLC v. Hartford Life Insurance Co.*, 69 USPQ2d at 2000 (citations omitted).

69. In summary, examiners recognize that drafting patent applications is a complicated process requiring the drafter to consider many complex issues.<sup>34</sup> However this does not relieve the drafter of deciding whether or not to be their own lexicographer and if affirmative, unequivocally stating those definitions in the specification. Such definitions and associated issues must be contemplated *prior to* filing the patent application. See *Intellicall, Inc. v. Phonometrics, Inc.*, 952 F.2d 1384, 21 USPQ2d 1383 (Fed. Cir. 1992) noting that for lexicography and quoting *Lear*, “the place to do so is in the specification of the inventor’s application, and the time to do so is *prior to* that application acquiring its own independent life as a technical disclosure through its issuance as a United States patent. [Emphasis added.]” *Intellicall*, 952 F.2d at 1388, 21 USPQ2d at 1386.

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<sup>34</sup> See e.g. *Johnson & Johnston Associates*, 285 F.3d at 1069, 62 USPQ2d at 1241, Newman, J., dissenting (“Patentees often must draw lines in order to claim their invention with specificity.”).

*What Does the Examiner Want?*

70. The Examiner has simply reminded Applicants that their response(s) must comply with all statutes, rules, and requirements including 37 C.F.R. §1.111(b).<sup>35</sup>

71. Additionally, the record will reveal that the Examiner has never *required* Applicants to be their own lexicographer. It is Applicants' burden to define their invention, not the Examiner's.<sup>36</sup>

In complying this burden, Applicants are reminded that it is Applicants—and *not* the Examiner—who drafted the claims, specification, and drawings and it is therefore *Applicants* who must have decided whether or not to be their own lexicographer. Along the same line of reasoning, whether or not Applicants chose a particular method of claim construction (*e.g.* lexicography, 35 U.S.C. §112 6<sup>th</sup> paragraph, or some other method of claim construction) was also completely within Applicants' discretion.

72. Applicants are also reminded that the USPTO has the authority to set reasonable deadlines or requirements. "The PTO is the administrative agency that is 'responsible for the granting and issuing of patents . . . .' 35 U.S.C. §2 (2000). Like other administrative agencies, the PTO may impose reasonable deadlines and requirements on parties that appear before it. The PTO has inherent authority to govern procedure before the PTO, and that authority allows it to set reasonable deadlines and requirements for the prosecution of applications." *In re Bogese*, 303 F.3d 1362, 1367-68, 64 USPQ2d 1448, 1452 (Fed. Cir. 2002) (footnote omitted). Although

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<sup>35</sup> See *Jaskiewicz v. Mossinghoff*, 822 F.2d 1053, 3 USPQ2d 1294, (Fed. Cir. 1987) (noting that "the PTO is under severe limitations as to time and manpower, and it is incumbent upon attorneys and agents who prosecute patent applications to follow the procedural rules of the PTO.").

<sup>36</sup> *In re Morris*, 127 F.3d at 1056, 44 USPQ2d at 1029 (quoting 35 U.S.C. §112 2<sup>nd</sup> paragraph, "It is the applicants' burden to precisely define the invention, not the PTO's.").

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*Bogese* concerned latches, the concept of imposing reasonable deadlines and requirements upon applicants is pervasive at the USPTO and is generally accepted as a requirement of 37 C.F.R. §1.111(b).

73. Having established that claim terms are fixed upon filing, that Applicants are the masters of their domain, and that the USPTO can set reasonable deadlines or requirements, the Examiner has simply required that for the four (4) reasons stated earlier, if Applicants *know of or intended* to be their own lexicographer, the Examiner respectfully requested that they point it out now. After the Examiner has brought this issue to Applicants' attention and after the Examiner has shown reliance on the *lack* of lexicographic definition(s) to interpret the claims, Applicants' continued failure to point out any *known* lexicographic definition(s) would be a violation of 37 C.F.R. §1.111(b). Issues of quasi-estoppel may also arise. See *In re Baker Hughes Inc.*, 215 F.3d 1297, 1301, 55 USPQ2d 1149, 1152 (Fed. Cir. 2000). Thus, 37 C.F.R. §1.111(b), and/or the implications of quasi-estoppel require Applicants in this particular case to point out any *known* lexicographic terms.

***So Whose Burden Is It to Overcome the Broadest Reasonable Interpretation?***

74. Unless the specification clearly requires otherwise, it is an *applicant's* burden to overcome the broadest reasonable interpretation or the ordinary and accustomed meaning. "[A] party wishing to alter the meaning of a clear claim term must overcome the presumption that the ordinary and accustomed meaning is the proper one, demonstrating why such an alteration is required." *K-2 Corp. v. Salomon S.A.*, 191 F.3d 1356, 52 USPQ2d 1001, 1004 (Fed. Cir. 1999)(citations omitted). See also *Johnson Worldwide Assocs.*, 175 F.3d at 989, 50 USPQ2d at 1610 ("In order to overcome this heavy presumption in favor of the ordinary

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meaning of claim language, it is clear that a party wishing to use statements in the written description to confine or otherwise affect a patent's scope must, *at the very least*, point to a term or terms in the claim with which to draw in those statements. [Emphasis added.]”).

75. Because it is the patent applicant who drafted the specification and claims, it is the patent applicant who must make any lexicographic decisions. “[I]t is well settled, however, that it is the applicant, not the examiner, who must give up or disclaim subject matter that would otherwise fall within the scope of the claims.” *Innova/Pure Water, Inc. v. Safari Water Filtration Sys.*, 381 F.3d 1111, 1124, 72 USPQ2d 1001, 1010 (Fed. Cir. 2004). See also *Lear Siegler, Inc. v. Aeroquip Corp.*, 221 USPQ at 1031 (noting that “It is the inventor applying for a patent who is permitted to be his own lexicographer”).

76. In conclusion, because this is ex parte examination, because of the initial ‘heavy presumption’ noted above, because the Examiner is *obligated* to initially give claims their ‘broadest reasonable interpretation,’ because it is the patent applicant who drafted the specification and claims, and because a party wishing to use statements in the written description to confine or otherwise affect a patent’s scope *must at the very least*, point to a term or terms in the claim with which to draw in those statements, it is an applicant’s burden to objectively demonstrate that he or she intends to alter the meaning of any claim term(s) by redefining those claim term(s) with the required clarity, deliberateness, and precision.<sup>37</sup>

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<sup>37</sup> See again *Renishaw PLC v. Marposs Societa’ per Azioni*, 158 F.3d at 1249, 48 USPQ2d at 1121 citing *In re Paulsen*, 30 F.3d at 1480, 31 USPQ2d at 1674, *supra*.

***Invocation Decisions Have Already Been Made by Applicants***

77. The decision of whether a patent applicant is his or her own lexicographer was finalized on the effective filing date of the application. Lexicography invocation is therefore based upon objective evidence that existed on the effective filing date. While applicants frequently make such comments such as they ‘reserve the right to be their own lexicographer,’ their reservation is legally pointless<sup>38</sup> since they have already made their decision.

78. The reason this decision has already by made by the applicant is primarily because claim terminology is fixed upon filing. See *PC Connector Solutions LLC v. SmartDisk Corp.*, 406 F.3d 1359, 1363, 74 USPQ2d 1698, 1700 (Fed. Cir. 2005) (“A claim cannot have different meanings at different times; its meaning must be interpreted as of its effective filing date.”); *Middleton Inc. v. Minnesota Mining and Manufacturing Co.*, 311 F.3d 1384, 1389, 65 USPQ2d 1138, 1142 (Fed. Cir. 2002) (“The meaning of a patent term, however, is not subject to revision . . . . The meaning of patent terms depends on the usage of those terms in context by one of skill in the art *at the time of application*. [Emphasis added.]”); *Wiener v. NEC Elecs., Inc.*, 102 F.3d 534, 539, 41 USPQ2d 1023, 1027 (Fed. Cir. 1996) (“Ultimately, a court must construe the claim language according to the standard of what those words would have meant to one skilled in the art *as of the application date*. [Emphasis added.]”)(overruled on other grounds in *Cybor Corp. v. FAS Techs., Inc.*, 138 F.3d 1448, 1454-55, 46 USPQ2d 1169, 1173 (Fed. Cir. 1998) (en banc)); *Plant Genetic Systems N.V. v. DeKalb Genetics Corp.*, 315 F.3d 1335, 1345, 65 USPQ2d 1452, 1460 (Fed. Cir. 2003)(“We hold that the district court did not ignore the plain meaning of the claims,

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<sup>38</sup> It is the Examiner’s position that such reservations are legally pointless during ex parte examination. The Examiner makes no findings on the effect of such reservations during a subsequent post issuance, inter partes litigation.

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but properly gave objective meaning to them as they were understood *at the time the patent application was filed*. [Emphasis added.]”); and *Kopykake Enterprises Inc. v. Lucks Co.*, 264 F.3d 1377, 1383, 60 USPQ2d 1124, 1127 (Fed. Cir. 2001) (“[W]hen a claim term understood to have a narrow meaning when the application is filed later acquires a broader definition, the literal scope of the term is limited to what it was understood to mean at the time of filing.”). So once an applicant files his or her specification, the meaning of *all* claim terms—both lexicographic and non-lexicographic—are fixed.

79. Because claim terminology is fixed upon filing, if an objective review of the specification reveals that the applicant has redefined a claim term using lexicography, the applicant is bound by that definition. The applicant can not subsequently change or modify that lexicographic definition. See *e.g. In re Bass*, 314 F.3d at 577-78, 65 USPQ2d at 1158 (noting that “Bass chose to define ‘motorized sports boat’ in the specification. He cannot change or modify that definition on appeal.”).

80. In fact and to go one step further, where the objective evidence indicates a successful lexicographic invocation, even where it is unintended, the objective evidence ultimately controls and lexicography will be invoked. “Because the inquiry into the meaning of claim terms is an objective one, a patentee who notifies the public that claim terms are to be limited beyond their ordinary meaning to one of skill in the art will be bound by that notification, even where it may have been unintended.” *Innova/Pure Water, Inc. v. Safari Water Filtration Sys.*, 381 F.3d 1111, 117, 72 USPQ2d 1001, 1005 (Fed. Cir. 2004)(citations and quotations omitted).

81. The converse is equally true. As of the effective filing date, if an objective review of the specification reveals that the applicant has *not* redefined a claim term using lexicography with the required clarity, deliberateness, and precision, even if the applicant harbored a subjective



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intent to do so, lexicography cannot be invoked. See *e.g. In re Thrift*, 298, F.3d 1357, 1364, 63, USPQ2d 2002, 2006 (Fed. Cir. 2002) (“Although an applicant may be his own lexicographer, nothing in the specification defines the phrase ‘speech user agent’ differently from its ordinary meaning.”) (citations omitted).<sup>39</sup>

82. This makes sense because it is not applicant’s subjective intent that governs but the objective evidence as of effective filing date that governs. “The subjective intent of the inventor when he used a particular term is of little or no probative weight in determining the scope of a claim (except as documented in the prosecution history [such as in prosecution disclaimer, *CCS Fitness Factor #3*]). The focus is on the objective test of what one of ordinary skill in the art at the time of the invention would have understood the term to mean.” *Biogen, Inc. v. Berlex Laboratories, Inc.*, 318 F.3d 1132, 1139-40, 65 USPQ2d 1809, 1815 (Fed. Cir. 2003) (citations and quotations omitted).

83. In this case, because Applicant has not overcome the heavy presumption in favor of the ordinary and accustomed meaning and because Applicants have not overcome the broadest reasonable interpretation with the required clarity, deliberateness, and precision, it is the Examiner’s position that Applicants are not, or more precisely, *were* not their own lexicographer.

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<sup>39</sup> See also *Process Control Corp. v. Hydrex Corp.*, 190 F.3d 1350, 52 USPQ2d 1029, 1033 (Fed. Cir. 1999)(noting that “[w]hile we have held many times that a patentee can act as his own lexicographer to specifically define terms of a claim contrary to their ordinary meaning, the quoted portions from the written description above do not so clearly redefine ‘the discharge rate’ . . . so as to put a reasonable competitor or one reasonably skilled in the art on notice that the patentee intended to so redefine that claim term.”); *Abbott Labs. v. Baxter Pharm. Prods.*, 67 USPQ2d 1191, 1194 (Fed. Cir. 2003)(“Because the patentee did not deviate from the accustomed meaning of the disputed claim term, the term ‘effective amount’ is construed in view of its ordinary and customary meaning.”).

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84. Applicants response is acknowledged and noted for the record. It is the Examiner's position however that such issues are, or more precisely, *were* at issue. Moreover and as noted above, the Examiner respectfully disagrees since such 'reservations' are legally moot—at least for ex parte examination purposes. In any event, one point however is clear, such Remarks by Applicants regarding lexicography unmistakably confirm that Applicants have *again* received actual notice of the Examiner's factual findings and legal conclusions regarding lexicography invocation (including the lack of lexicography invocation) and have been given the opportunity to defend against the noticed liabilities.

***Regarding Indefiniteness Under 35 USC §112 2<sup>nd</sup> Paragraph<sup>40</sup>***

85. First, the Examiner notes that the primary purpose of the definiteness requirement is to provide notice. "The primary purpose of the definiteness requirement is to ensure that the claims are written in such a way that they give notice to the public of the extent of the legal protection afforded by the patent, so that interested members of the public, e.g., competitors of the patent owner, can determine whether or not they infringe. That determination requires a construction of the claims according to the familiar canons of claim construction." *All Dental Prodx, LLC v. Advantage Dental Products, Inc.*, 309 F.3d 774, 779-80, 64 USPQ2d 1945, 1949 (Fed. Cir. 2002) (citations omitted).

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<sup>40</sup> Because this application has now been at least twice rejected and is therefore eligible for appeal to the USPTO's Board of Patent Appeals and Interferences ("Board"), because of recent decisions by the Board and the Board's position on indefiniteness, and in order to help and enable Applicant(s) to craft reasoned arguments should Applicant(s) eventually decide to appeal an indefiniteness rejection to the Board, the Examiner has provided the following discussion on 35 USC §112 2<sup>nd</sup> Paragraph and indefiniteness.

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86. Second, it is the Examiner's position that during ex parte examination, if a claim in a utility patent application is indefinite on its face, the claim is indefinite. "If the scope of the invention sought to be patented is unclear from the language of the claim, a second paragraph rejection will properly lie." *In re Wiggins*, 488 F.2d 538, 179 USPQ 421, 423 (CCPA 1973) (citations and quotations omitted). Moreover, this definiteness determination is made as of the effective filing date. See e.g. *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1385, 231 USPQ 81, 94-95 (Fed. Cir. 1986) (analyzing definiteness as of the filing date).

87. Third, if a claim is indefinite under 35 U.S.C. §112 2<sup>nd</sup> paragraph, it is impossible to completely and accurately construe claim scope. See *Honeywell International Inc. v. ITC*, 68 USPQ2d 1023, 1030 (Fed. Cir. 2003) ("Because the claims are indefinite, the claims, by definition, cannot be construed."). However, in accordance with MPEP §2173.06 and the USPTO's policy of trying to advance prosecution by providing art rejections even though these claim are indefinite, the claims are construed and the art is applied *as much as practically possible*.

88. Forth, the Examiner recognizes that breath of a claim is not be equated with indefiniteness. *In re Miller*, 441 F.2d 689, 169 USPQ 597 (CCPA 1971). However, "[i]f the language of the claim is such that a person of ordinary skill in the art could not interpret the metes and bounds of the claim so as to understand how to avoid infringement, a rejection of the claim under 35 U.S.C. 112, second paragraph would be appropriate." MPEP §2173.02 citing *Morton Int'l, Inc. v. Cardinal Chem. Co.*, 5 F.3d 1464, 1470, 28 USPQ2d 1190, 1195 (Fed. Cir. 1993). In other words, claim breath indicates the range or scope a claim limitation covers while the metes and bounds indicate where the claimed subject matter begins and ends. These are two principles are distinct and separate principles. A broad claim—like a narrow claim—may or

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may not have clear metes and bounds and thus may or may not be definite. Thus, if a person of ordinary skill in the art could not interpret the metes and bounds of a claim—even a broad claim—so as to understand how to avoid infringement, the claim is indefinite.

89. Fifth, a claim in a utility patent application is either indefinite under 35 U.S.C. §112, 2<sup>nd</sup> paragraph or it is not. Contrary to recent decisions of the USPTO's Board of Patent Appeals and Interferences ("Board"), the law does not recognize a 'scale' or 'range' of indefiniteness such as 'slightly indefinite,' 'somewhat indefinite,' or 'not too indefinite.' There is no middle ground since at the end of the day, 'slightly indefinite,' 'somewhat indefinite,' or 'not too indefinite' are nevertheless still indefinite. The Examiner frequently receives arguments from applicants and decisions from the Board where the parties respectively argue that 'the examiner knows what is meant by the term' or 'the language is clear from the specification.' However these arguments can not overcome claim language that is indefinite on its face. In other words, "semantic indefiniteness of claims is not rendered unobjectionable merely because it *could* have been corrected. [Emphasis in original.]" *Allen Engineering Corp. v. Bartell Industries Inc.*, 299 F.3d 1336, 1349, 63 USPQ2d 1769, 1776 (Fed. Cir. 2002) (citations and quotations omitted).<sup>41</sup>

Again, so as to be especially clear, a claim is either indefinite—or it is not indefinite. When the claim is indefinite, the claim by definition, can not be construed. And if the indefiniteness is

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<sup>41</sup> As a practical matter, a patent applicant almost always has an opportunity to correct indefiniteness by filing either an amendment to a non final office action, or alternatively if in response to a final office action, a request for continued examination under 37 C.F.R. §1.114 along with an amendment.

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rendered during ex parte examination, neither the specification nor the prosecution history can be used to rectify the indefiniteness.<sup>42</sup>

90. Sixth, the Examiner recognizes that “compliance with Section 112 Para. 2 is a question of law.” *In re Dossel*, 115 F.3d 942, 944, 42 USPQ2d 1881, 1883 (Fed. Cir. 1997). Additionally, when questions of indefiniteness arise, we use general principles of claim construction. “In the face of an allegation of indefiniteness, general principles of claim construction apply.” *Datamize LLC v. Plumtree Software Inc.*, 417 F.3d 1342, 75 USPQ2d 1801, 1805 (Fed Cir. 2005) citing *Oakley, Inc. v. Sunglass Hut Int’l*, 316 F.3d 1331, 1340-41, 65 USPQ2d 1321, 1326 (Fed. Cir. 2003) (noting that a determination of definiteness “requires a construction of the claims according to the familiar canons of claim construction”). However, a patent claim that is indefinite on its face can not be rendered ‘definite’ by a reviewing body simply because the result would otherwise be inequitable or unfair to applicant, because the result would otherwise be too harsh or severe since it might result in the patent application becoming abandoned, or because rendering the claim indefinite is against some noble policy. “Claim construction, however, is not a policy-driven inquiry. As stated earlier, it is a contextual interpretation of language. The scope of patent claims can neither be broadened nor narrowed based on abstract policy considerations regarding the effect of a particular claim meaning.” *SmithKline Beecham Corp. v. Apotex Corp.*, 365 F.3d 1306, 70 USPQ2d 1737, 1742-43 (Fed. Cir. 2004) (quoting *Quantum Corp. v. Rodime, PLC*, 65 F.3d 1577, 1584, 36 USPQ2d 1162, 1168 (Fed. Cir. 1995))

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<sup>42</sup> Compare *Exxon Research and Engineering Co. v. U.S.*, 265 F.3d 1371, 60 USPQ2d 1272 (Fed. Cir. 2001) vs. *In re Jolly*, 172 F.2d 566, 80 USPQ 504 (CCPA 1949). In *Exxon Research*, the Court of Appeals for the Federal Circuit reviewed “similar claim language” as was interpreted in *Jolly* (where the language in question was held to be indefinite) and held that for purposes of indefiniteness, claims are interpreted differently during ex parte examination than the same claim phases during inter parte litigation.

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(“[I]t is well settled that no matter how great the temptations of fairness or policy making, courts do not redraft claims”), *vacated on other grounds by* 403 F.3d 1328, 74 USPQ2d 1396 (Fed. Cir. 2005)(en banc).

91. Seventh, should Applicants appeal this application and should the Board have any questions regarding indefiniteness under 35 U.S.C. §112, 2<sup>nd</sup> paragraph and its application during *ex parte* examination when compared with *inter parte* litigation, the Examiner respectfully requests the Board to remand this application to the Examiner in order to provide additional guidance.

92. The Examiner concludes this section by reiterating that during *ex parte* examination, when a patent claim is rejected for indefiniteness because the claim is indefinite on its face, the claim can not be construed. In such a case, the application of prior art by an examiner or the Board is immaterial. Yet in order to avoid piecemeal examination, MPEP §2173.06 states that even if the examiner takes a position that a claim is indefinite, it is USPTO policy to nevertheless make an attempt at application of the prior art. However, neither this policy decision as set forth in MPEP §2173.06 nor even *any* policy decision by the USPTO can change the substantive standard for indefiniteness and thus the standard for a 35 U.S.C. §112 2<sup>nd</sup> paragraph rejection.<sup>43</sup> So no matter how slight the indefiniteness may be, no matter how equitable applicant's arguments may seem, and no matter how great the temptations of fairness or policy making may

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<sup>43</sup> See *Merck & Co. v. Kessler*, 80 F.3d 1543, 1559, 38 USPQ2d 1347, 1351 (Fed. Cir. 1996)(“As we [the Federal Circuit] have previously held, the broadest of the PTO's rulemaking powers—35 U.S.C. Section 6(a)—authorizes the Commissioner to promulgate regulations directed only to ‘the conduct of proceedings in the [PTO]’; it does not grant the Commissioner the authority to issue substantive rules.”).

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appear to the Board, during ex parte examination, if a claim is indefinite on its face, the claim is just that—indefinite.

### ***Conclusion***

93. Applicants' amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP §706.07(a). Applicants are reminded of the extension of time policy as set forth in 37 C.F.R. §1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

94. References considered pertinent to Applicants' disclosure are listed on form PTO-892. All references listed on form PTO-892 are cited in their entirety.

95. Unless expressly noted otherwise by the Examiner or other USPTO official, the following four (4) citations to the Manual of Patent Examining Procedure ("MPEP") apply to this Office Action *and* any future office action(s), communication(s), or other correspondence provided by the USPTO: MPEP citations to Chapter 2300 are from the MPEP 8<sup>th</sup> Edition, Rev. 4, October 2005; citations to Chapters 200-900, 1200-1400, and 1700-1900, 2100, 2200, 2600 are from the MPEP 8<sup>th</sup> Edition, Rev. 3, August 2005. MPEP citations to Chapters 100, 1000, 1100,

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1500, 2000, 2500, and 2700 are from the MPEP 8<sup>th</sup> Edition, Rev. 2, May 2004. MPEP citations to Chapters 1600, 2300, 2400 are from MPEP 8<sup>th</sup> Edition, August 2001.

96. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

97. Applicants are reminded that patents are written by and for skilled artisans. See *e.g Vivid Technologies, Inc. v. American Science and Engineering, Inc.*, 200 F.3d 795, 804, 53 USPQ2d 1289, 1295 (Fed. Cir. 1999) (“patents are written by and for skilled artisans”). The Examiner therefore starts with the presumption that Applicants are skilled artisans who possess at least ordinary skill in the art. Consequently, it is the Examiner’s position that because the patent references of record are directed to those with ordinary skill in this art, these references are clear, explicit, and specific as to what they teach. Nevertheless some applicants apparently have difficulty understanding the references. In an effort to maintain compact prosecution, provide due process, and to help these applicants understand the contents of a reference when viewed from the position of one of ordinary skill in this art, Applicants are hereby given actual notice that if after reasonably reading any reference of record—whether the reference is currently of record or subsequently made of record—if Applicants can not reasonably understand or if Applicants have difficulty comprehending one or more sentence(s), statement(s), diagram(s), or principle(s) set forth in the reference(s), Applicants should (in their next appropriately filed response) bring this issue to the attention of the Examiner. In addition to bringing this issue to



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the attention of the Examiner, and in accordance with 37 C.F.R. §1.111(b), Applicants' response must also state *why* they either do not understand or *why* they have difficulty comprehending the offending reference(s). If after properly receiving (*i.e.* Applicant's response is made of record) both Applicant's request for understanding and the reasons as to *why* the request is made—and assuming the reference is germane to at least one outstanding rejection—the Examiner may either provide a substitute reference, or alternatively, do his best to elucidate the particular sentence(s), statement(s), diagram(s), or principles(s) in the offending reference. For all documents or references made of record after this Office Action, Applicant is given actual notice that this paragraph becomes effective when Applicant receives notice that the document or reference is made of record (*i.e.* this paragraph becomes applicable when Applicant submits an Information Disclosure Statement or when Applicant receives an examiner's Notice of References Cited (Form PTO-892)).

98. Additionally, Applicants are reminded that it is inappropriate for the USPTO to disregard any relevant evidence. "It is jurisprudentially inappropriate to disregard any relevant evidence on any issue in any case, patent cases included." *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871, 879 (Fed. Cir. 1983). Second, when making substantive patentability determinations, it is clear error for the USPTO not to consider *all* evidence of record. See *e.g. In re Piasecki*, 745 F.2d 1468, 1471, 223 USPQ 785, 787 (Fed. Cir. 1984) ("All the evidence on the question of obviousness must be considered."); *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992) ("After evidence or argument is submitted by the applicant in response, patentability is determined on *the totality of the record*, by a preponderance of evidence with due consideration to persuasiveness of argument. [Emphasis added.]"); *In re Glaug*, 283 F.3d 1335, 1338, 62 USPQ2d 1151, 1152-53 (Fed. Cir. 2002) ("Patentability vel non

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is then determined on the *entirety* of the record, by a preponderance of evidence and weight of argument. . . . ; patentability is determined by a preponderance of *all* the evidence. [Emphasis added.]”); and *In re Rinehart*, 531 F.2d 1048, 189 USPQ 143, 146 (CCPA 1976)(where the court expressly set forth the issue as “Whether, in light of *all the evidence*, the claimed method would have been obvious at the time the invention was made. [Emphasis added.]”). Third, any factual determination by the USPTO that does not consider *all* relevant evidence may not be supported by substantial evidence<sup>44</sup> since the particular evidence *not* considered may be probative of a factual issue presented. Forth, it is well established that “[a] reference anticipates a claim if it discloses the claimed invention ‘such that a skilled artisan could take its teachings in *combination with his own knowledge of the particular art and be in possession of the invention*. [Emphasis in original.]’” *In re Graves*, 69 F.3d 1147, 1152, 36 USPQ2d 1697, 1701 (Fed. Cir. 1995) citing *In re LeGrice*, 301 F.2d 929, 936, 133 USPQ 365, 372 (CCPA 1962) and noting that regarding the claimed “simultaneously monitoring the selected multiple connection points,” the prior art “nevertheless anticipates [the claimed invention], even if it does not specifically disclose simultaneous monitoring of the output points, if simultaneous or parallel monitoring is within the knowledge of a skilled artisan.” *Graves*, 69 F.3d at 1152, 36 USPQ2d at 1701.<sup>45</sup> Therefore because, inter alia, it is inappropriate for the USPTO to disregard any relevant evidence, because the USPTO must consider all evidence of record, because any evidence *not* considered by the USPTO may be probative of at least one factual issue presented, and because

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<sup>44</sup> Substantial evidence is “such relevant evidence as a reasonable mind might accept as adequate to support a conclusion.” *Consolidated Edison Co. v. NLRB*, 305 U.S. 197, 229 (1938).

<sup>45</sup> See also *In re Donohue*, 766 F.2d 531, 533, 226 USPQ 619, 621 (Fed. Cir. 1985) for the same statement of law and also citing *In re LeGrice*.

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anticipation is determined by the teachings of a reference in combination with the knowledge of one of ordinary skill in the art, Applicants are hereby given actual notice that all prior art rejections (*i.e.* rejection(s) based upon 35 U.S.C. §§ 102 or 103)—if found in this Office Action or any subsequent office action—are based upon the cited reference(s) in the statement of the rejection in combination with the knowledge of one of ordinary skill in this art.

99. Because this application is now final, Applicants are reminded of the USPTO's after final practice as discussed in MPEP §714.12 and §714.13 and that entry of amendments after final is *not* a matter of right. "The refusal of an examiner to enter an amendment after final rejection of claims is a matter of discretion." *In re Berger*, 279 F.3d 975, 984, 61 USPQ2d 1523, 1529 (Fed. Cir. 2002) (citations omitted). Furthermore, suggestions or examples of claim language provided by the Examiner are just that—suggestions or examples—and do not constitute a formal requirement mandated by the Examiner. Unless stated otherwise by an express indication that a claim is "allowed," exemplary claim language provided by the Examiner to overcome a particular rejection or to change claim interpretation has *not been addressed* with respect to other aspects of patentability (*e.g.* §101 patentable subject matter, §112 1<sup>st</sup> paragraph written description and enablement, §112 2<sup>nd</sup> paragraph indefiniteness, and §102 and §103 prior art). Therefore, any claim amendment submitted under 37 C.F.R. §1.116 that incorporates an Examiner suggestion or example or simply changes claim interpretation will nevertheless require further consideration and/or search and a patentability determination as noted above.

100. In accordance with the USPTO's goals of customer service, compact prosecution, and reduction of cycle time, the Examiner has made every effort to clarify his position regarding claim interpretation and any rejections or objections in this application. Furthermore, the Examiner has again provided Applicants with notice—for due process purposes—of his position

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regarding his factual determinations and legal conclusions. The Examiner notes and thanks Applicants for their "Remarks" (beginning on page 23 of the response filed November 7, 2005) traversing the Examiner's positions on various points. If Applicants disagree with any additional factual determination or legal conclusion made by the Examiner in this Office Action whether expressly stated or implied,<sup>46</sup> the Examiner again respectfully reminds Applicants to properly traverse the Examiner's position(s) in accordance with 37 C.F.R. §1.111(b) in their next properly filed response. By addressing these issues now, matters where the Examiner and Applicants agree can be eliminated allowing the Examiner and Applicants to focus on areas of disagreement (if any) with the goal towards allowance in the shortest possible time. If Applicants have any questions regarding the Examiner's positions or have other questions regarding this communication or even previous communications, Applicants are strongly encouraged to contact Examiner Andrew J. Fischer whose telephone number is (571) 272-6779. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's immediate supervisor, Alexander Kalinowski, can be reached at (571) 272-6771. The fax number for facsimile responses is now (571) 273-8300.



Andrew J. Fischer  
Primary Examiner  
Art Unit 3627

AJF  
January 25, 2006

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<sup>46</sup> *E.g.*, if the Examiner rejected a claim under §103 with two references, although not directly stated, it is the Examiner's implied position that the references are analogous art.